

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1-23 will have been canceled and claims 24-30 will have been submitted for consideration by the Examiner.

In view of the above, Applicants respectfully request reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided, for the acceptance of the drawings filed in the present application on June 17, 1999, for the acknowledgment of Applicants' claims for priority under 35 U.S.C. § 119 and receipt of the certified copies of the priority documents in the Official Action. Applicants further note with appreciation the Examiner's acknowledgment of Applicants' Information Disclosure Statements filed in the present application on June 13, 2000, January 8, 2001 and October 22, 2002 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

However, Applicants have also filed an Information Disclosure Statement in the present application on September 17, 1999. Thus, Applicants respectfully request that the Examiner send a copy of the appropriate signed PTO-1449 Form to Applicants with the next Official Action to confirm consideration of the documents cited therein.

Turning to the merits of the action, The Examiner has objected to claims 2 and 15 because of missing words. The Examiner has rejected claims 5 and 17 under 35 U.S.C. §

112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner has rejected claims 1, 10 and 14-23 under 35 U.S.C. § 103 as being unpatentable over SAITO et al. (U.S. Patent 6,266,160) in view of OHTO et al. (U.S. Patent 5,864,673).

As noted above, Applicants have canceled these rejected claims and have submitted new claims 24-30. Applicants respectfully traverse the above rejections based on newly added claims 24-30 and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The newly added claims merely clarify the subject matter recited in the canceled claims, but do not narrow the scope of the claims.

Applicants' claims 24-26 relate to a server apparatus connected with a transmitting facsimile and a receiving facsimile via the Internet. The server apparatus stores capabilities regarding facsimile data that the receiving facsimile can receive. The server apparatus receives facsimile data from the transmitting facsimile, transforms the received facsimile data into a type of facsimile data that the receiving facsimile can receive, based on the stored capabilities of the receiving facsimile, and transmits the transformed facsimile data to the receiving facsimile. Claim 30 recites a related method.

In contrast, the server apparatus disclosed in SAITO et al. does not store information regarding capabilities of the receiving facsimile, as the Examiner recognized.

On the other hand, OHTO et al. does not relate to a server apparatus connected with a transmitting facsimile and a receiving facsimile via the Internet, but to a terminal device and a relaying device that transmit a multimedia document consisting of different media attributes or types, such as audio data, character data, still image data, motion picture and hand-written data. The terminal device stores, not capabilities regarding facsimile data that a receiving facsimile can receive, such as, e.g., compression format, but the capacity of the terminal device to receive data. The capacity means the size of data that the terminal device can store, as described in OHTO et al. (col. 24, lines 58-67 and col. 25, lines 1-29 and Fig. 29).

OHTO et al. also relates to a terminal device that transmits a multimedia document, as explained above. The terminal device stores which types of devices the recipients are, such as telephones, facsimiles, PHS and so on. The terminal device submits a suitable part of a multimedia document based on a type of a recipient. For example, the terminal device transmits character data of a multimedia document to a character e-mail terminal of a recipient and transmits still image data of the multimedia document to a facsimile of the recipient, when character data and still image data are included in a multimedia document. However, in the present invention, it is not a transmitting facsimile but a server apparatus that stores capabilities of a receiving facsimile.

As the present invention relates to Internet facsimile transmission, a recipient can not be a telephone or a PHS, but is only a facsimile apparatus. The present invention

stores not media attributes (e.g., monochrome still picture for facsimile and audio for telephone) or types of recipients, but capabilities regarding facsimile data that a receiving facsimile can receive. Thus, OHTO et al. is very different from the present invention. OHTO et al. does not disclose a server apparatus that stores capabilities regarding facsimile data that the receiving facsimile can receive or a server apparatus that transforms facsimile data of a transmitting facsimile into a type of data that the receiving facsimile can receive, based on the stored capabilities of the receiving facsimile.

OHTO et al. relates to a terminal device that converts, e.g., character data into audio data, when a media attribute of a recipient is not "character", but "audio". However, the present invention does not relate to such a technology, because a recipient is always a facsimile apparatus.

Additionally the Examiner has not set forth a proper motivation for combining the teachings of these two references. In other words, the Examiner has set forth no logical or technical basis, in the prior art for combining the teachings of SAITO et al. which relate to an Internet facsimile apparatus with those of the terminal device of OHTO et al. which transmit different types of data from/to e.g. telephones, facsimiles mobile phones, handy phones and pagers.

SAITO et al. discloses storing, in a server, capabilities associated with e-mail address of relay apparatuses (col. 1, lines 62-65). On the other hand, OHTO et al. stores, in a terminal device, attributes relating to parts of document (Fig. 7, elements 707, 708). The Examiner has not set forth why one would combine these diverse teachings. The fact

that SAITO et al. would be “easily” modified or that such features are “cumulative” or “additive” (for which the Examiner has presented no evidence) are irrelevant, as the Examiner has set forth no motivation for the combination.

Further, even if combined as proposed, at best OHTO et al. would teach storing attributes of parts of a document in the server of SAITO et al. What purpose this would serve is unclear and this is not what is recited in the pending claims.

Therefore, for each of the above reasons individually and certainly for all of the above reasons, it is respectfully submitted that the features recited in Applicants’ claims 24-26 and 30 are not disclosed in SAITO et al. and OHTO et al. asserted and combined by the Examiner and are not obvious to one of ordinary skill in the art at this time nor the time the invention was made.

Applicant’s claims 27-29 relate to a server apparatus and an Internet facsimile that transmit and receive an e-mail with a predetermined address. The e-mail with the predetermined address indicates the capabilities of the Internet facsimile apparatus to be stored in the memory of the server apparatus.

However, neither SAITO et al. nor OHTO et al. contain any disclosures about the e-mail with the predetermined address which indicates the capabilities of the Internet facsimile apparatus to be stored in the memory of the server apparatus.

Therefore, it is respectfully submitted that the features recited in Applicants’ claims 27-29 are not disclosed in SAITO et al. and OHTO et al. cited by the Examiner

and would not have been obvious to one of ordinary skill in the art at the time the invention was made.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection and an indication of the allowability of all the claims pending in the present application in due course.

SUMMARY AND CONCLUSION

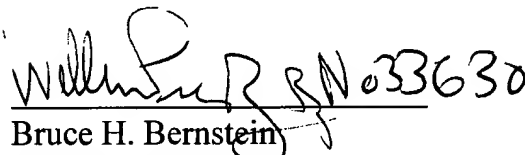
Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have canceled the rejected claims and have submitted new claims for consideration by the Examiner. With respect to the new claims, Applicants have pointed out the features thereof and have contrasted the features of the new claims with the disclosures of the references. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

P18051.A08

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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